



21 JUL 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. BOX 1450  
ALEXANDRIA, VA 22313-1450  
www.uspto.gov

M. Robert Kestenbaum  
11011 Bermuda Dunes NE  
Albuquerque, New Mexico 87111

|                                    |   |                       |
|------------------------------------|---|-----------------------|
| In re Application of               | : |                       |
| GNAUCK et al.                      | : |                       |
| Application No.: 10/500,591        | : | DECISION ON PETITION  |
| Filing Date: 30 December 2003      | : | UNDER 37 CFR 1.137(b) |
| Attorney Docket No.: (Z)00052PUS   | : |                       |
| For: DETECTOR FOR VARYING PRESSURE | : |                       |
| RANGES, AND ELECTRON               | : |                       |
| MICROSCOPE WITH A                  | : |                       |
| CORRESPONDING DETECTOR             | : |                       |

This is a decision on applicant's "Petition for Revival of an Application for Patent Designating the U.S. Abandoned Unintentionally under 37 CFR 1.137(b)" filed 30 December 2003.

### **BACKGROUND**

On 29 June 2001, applicants filed international application PCT/EP01/07431, which claimed a priority date of 07 July 2000 and designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 17 January 2002. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 07 January 2003.

On 30 December 2003, applicant filed, *inter alia*: a transmittal letter requesting entry into the national stage in the United States, which included: an application containing a specification, including claims and drawings; a basic national filing fee of \$1080; a substitute specification; an English translation of PCT/EP01/07431; an executed declaration of the inventors; and the instant petition and fee to revive the international application as to the United States under 37 CFR 1.137(b).

### **DISCUSSION**

International application PCT/EP01/07431 became abandoned as to the United States of America at midnight on 07 January 2003 for failure to pay the basic national fee.

#### **A. Conflict In Filing Instructions**

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions

set forth in 35 U.S.C. 371(c). See 37 CFR 1.494(f):

The documents and fees submitted . . . must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371, otherwise the submission will be considered as being made under 35 U.S.C. 111.

In addition, section 1893.03(a), page 1800-191 of the MPEP states that:

If there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a).

On 30 December 2003, applicants submitted a substitute specification which stated, "[t]his is a continuation application of PCT/EP01/07431 claiming priority of German Patent Applications 100 32 599.8 filed July 7, 2000 and 101 26 698.7 filed May 31, 2001." The statement is inconsistent with an intent to enter the national stage of the PCT under 35 U.S.C. 371. Accordingly, the original papers deposited on 30 December 2003 will be treated as a filing under 35 U.S.C. 111(a).

**B. Petition under 37 CFR 1.137(b)**

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

With regard to Item (1), the proper response was the filing of the continuing application.

As to Item (2), the appropriate petition fee of \$1330.00 has been submitted.

As to item (3), the statement "[t]he entire delay from the due date for filing a national phase application until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" and the prompt filing of the petition satisfies the requirement of 37 CFR 1.137(b)(3).

As to Item (4), the terminal disclaimer is not required since this application was filed after 08 June 1995.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate.

CONCLUSION

For the reasons discussed above, applicant's petition to revive international application PCT/EP01/07431 is GRANTED.

International application no. PCT/EP01/07431 is being revived for purposes of continuity only and since continuity has been established by this decision reviving the international application, the international application is again abandoned in favor of the continuing application number 10/500,591.

The application will then be forwarded to the Office of Initial Patent Examination for further processing under 35 U.S.C. 111(a).



Anthony Smith  
Attorney-Advisor  
Office of PCT Legal Administration  
Tel.: 703-308-6314  
Fax: 703-308-6459